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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,790	09/21/2000	Jan Slomianny	200-19	1128

7590

08/19/2003

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EXAMINER

NGUYEN, JUDY

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,790

Applicant(s)

SLOMIANNY ET AL.

Examiner

Judy Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-23 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-15 and 18-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 08 October 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election of species I in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 16, 17, 21-23 are continued to be withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.

Drawings

3. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 10/8/02 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of two bottles in Figure 2. The original claim 1 recited at least four bottles, not two. In addition, the original claim 1 does

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not support the particular structure of the two bottles as illustrated in the amended Figure 2.

Specification

4. The amendment filed 10/8/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the insertion of the first two lines on page 12, between lines 11 and 12 reference to Figure 2. The original specification does not support two bottles one filled with solvent and the other with pigment.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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6. Claims 9-11, 14, 15, 18-20 are rejected under 35 U.S.C. 102(a) as being anticipated by Cowger et al (US 5,788,388).

Cowger et al discloses:

- A computer (37) having a time unit (inherent because it is necessary to compare the expiration date in the chip mentioned at column 5, lines 21-25)
- At least one exchangeable reservoir bottle (12)
- An intermediate container (32)
- A suction pipe (35) and a pump (86)
- A sensor arrangement (92)
- A label (20) carrying coded information
- Means (72) for feeding the label information into the computer when the reservoir bottle is inserted into the printer
- A test program (inherent because it is necessary to determine whether to permit or inhibit printing; column 6, first two paragraphs)
- A memory (column 6, line 8)
- Functional languages are inherent by the structures listed above.

Claim Rejections - 35 USC § 103

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7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cowger et al in view of Erickson (US 5,369,429).

Cowger et al discloses all elements of the claimed invention except for the volume of the reservoir bottle being more than six or ten times the volume of the intermediate container.

However, Erickson discloses the volume a reservoir (48) being more than six or ten times (column 3, first paragraph; column 5, lines 7-15) the volume of an intermediate container (24).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the reservoir with the volume of more than six or ten times the volume of the intermediate container as taught by Erickson in the teaching of Cowger et al for the purpose of extending the useful life of the print head.

Response to Arguments

9. Applicant's arguments have been fully considered but they are not persuasive.

Applicant argued that claims 16 and 17 are believed allowable because of their dependence upon new claim 9, which is generic between species II and I.

However, since claim 9 is being rejected, claims 16 and 17 are not allowable due to their dependencies.

Applicant argued that claims 21-23 are not believed to read on to species II and should be considered for further examination. However, these claims were considered as having new matter, as opposed to being read on species II.

Applicant argued that claims 7 and 10 filed in the PCT application clearly contemplated the use of at least two bottles. Thus, no new matter was introduced into the drawings in the amendment of Figure 2. It is noted, however, that claims 7 and 10 also require the two bottles to be different, not identical as illustrated in the proposed amendment of Figure 2. Furthermore, claims 7 and 10 would read on species III and would be withdrawn for consideration for being directed to a non-elected species.

Applicant basically argued that Cowger's well 76 is not comparable to the separate intermediate container of the present claims. However, the examiner had indicated that structure 32 (not 76) is an intermediate container. In addition, applicant argued that Cowger does not teach a suction pipe or pump arranged between an intermediate container and a bottle. The examiner disagreed, the rejection was clearly set forth the suction pipe 35 and the pump 86. Although Cowger refers 35 as ink tube, the tube 35 sucks ink into the intermediate container 32. Hence, it is read as a suction pipe.

10. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory


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period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy Nguyen whose telephone number is (703) 305-7062. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Fuller can be reached on (703) 308-0079. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


Judy Nguyen
Primary Examiner
August 18, 2003